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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/774,084

02/06/2004

Wayne Boga

METSO-19

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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

10/18/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/774,084

Applicant(s)

BOGA ET AL.

Examiner

Lawrence D. Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed August 6, 2007.
Claims 15-16, 29-30 and 34 were amended rendering claims 15-34 pending.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections – 35 USC § 103(a)

3. Claims 15 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Persson et al (U.S. 6,436,241).

Persson discloses a suction roll seal strip comprising a mixture of rubber and graphite (column 3, line 49 through column 4, line 2). The seal strip is placed in a vacuum box (column 3, lines 49-50). In claim 30, the phrase, "for rotation around the suction box" is an intended use, which is given little patentable weight. In claim 30, the phrase, "to form a seal between the suction box and the inner surface of the cylindrical roll so that the seal strip wipes against the inner surface of the cylindrical roll as it rotates" introduces a process limitation to the product claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re

Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966. Further, process limitations are given no patentable weight in product claims. In claims 15 and 30, the phrase, "to allow a seal with a cross-section of 1.9cm by 4.8 cm to be bent into a reel with a radius of less than 150 cm", constitutes a 'capable of' limitation and that such a recitation that an element is 'capable of' performing a function is not a positive limitation but only requires the ability to so perform.

Although Persson does not teach cross section, radius or flexibility of the seal material, it would have been obvious to one of ordinary skill in the art to include these features because Persson teaches the same materials having the same function as applicants claimed invention. With respect to the claimed teach cross section, radius and flexibility of the composite laminate, these features are directly related to the specific mixture used.

Claim Rejections – 35 USC § 103(a)

4. Claims 16-23, 26 and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Persson et al (U.S. 6,436,241) in view of Selover, Jr. et al. (U.S. 4,014,730).

Persson is relied upon for instant claims 15 and 30 as above. Persson does not disclose a wax in the rubber and graphite mixture. Selover, Jr. teaches a sealant, where the sealant is a polymer such as natural or nitrile rubber, which is incorporated into a graphite sheet (column 2, lines 18-35 and 49-67) where wax is mixed with the graphite-

rubber composite (column 3, lines 1-7) as in claims 16 and 18-19. The reference teaches the wax is 2% parts by weight of the mixture and the mixture further can include sulfur at 2% parts by weight (column 5, lines 50-55) and the graphite (carbon black) is less than about 50 parts per hundred parts of rubber (column 6, lines 49-51) which meets the limitation of instant claim 20. Persson and Selover, Jr. are combinable because they are related to a similar technical field, which is sealants. Therefore, it would have been obvious to one of ordinary skill in the art to have employed the wax and sulfur at the weight percentages, as taught in Selover, Jr., in the seal strip of Persson because when a patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement, the combination is proper.

Claim Rejections – 35 USC § 103(a)

5. Claims 24-25, 27-29 and 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Persson et al (U.S. 6,436,241) in view of Selover, Jr. et al. (U.S. 4,014,730) further in view of Sale et al (U.S. 6,258,409).

Persson and Selover, Jr. are relied upon for instant claims 15 and 30. Persson and Selover, Jr. do not disclose a specific wax material, as cited in claims 27-29 and 34. Sale teaches a sealant with a wax comprising ethylene bis-stearamide, which has a melting point of about 110°C to about 180°C (column 1, lines 11-25 and column 4, lines 6-13 and 44-48). Sale further teaches polyethylene waxes (polyolefin waxes) have been

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used in sealants as well (column 6, lines 30-40). It would have been obvious to one of ordinary skill in the art to have employed the ethylene bis-stearamide wax, as taught in Sale, in the sealant mixture of Persson and Selover, Jr. because the ethylene bis-stearamide wax retains the integrity of the seal.

Response to Arguments

6. The rejection made under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn due to Applicant amending claim 30.

The objection of claim 29 is withdrawn due to Applicant amending claim 29.

The rejection made under 35 U.S.C. 103(a) as being unpatentable over Selover, Jr. et al. (U.S. 4,014,730) is withdrawn due Applicant amending the claims.

The rejection made under 35 U.S.C. 103(a) as being unpatentable over Selover, Jr. et al. (U.S. 4,014,730) in view of Sale et al (U.S. 6,258,409) is withdrawn due Applicant amending the claims.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



L. Ferguson
Patent Examiner
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MILTON I. CANO
SUPERVISORY PATENT EXAMINER